APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,683	07/20/2001	Neil J. Kiely	0178-2002	2976

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EXAMINER
LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/910,683	KIELY ET AL.
	Examiner	Art Unit
	Jennifer Liversedge	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 July 2001</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 July 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _12/12/01 and 6/3/2002_

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this

application because all drawings in their current form are free-hand drawings. Applicant

is advised to employ the services of a competent patent draftsperson outside the Office,

as the U.S. Patent and Trademark Office no longer prepares new drawings. The

corrected drawings are required in reply to the Office action to avoid abandonment of

the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-25 and 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated

by U.S. Patent No. 6,405,174 B1 to Walker et al. (further referred to as Walker 02).

Regarding claim 1, Walker 02 discloses a method of transacting commerce on a network having a client system (column 3, lines 20-27), an upsell server system (column 3, lines 3-6; column 7, lines 33-37; column 12, lines 2-9), and an affiliate server system (column 3, lines 3-6; column 7, lines 8-12; column 12, lines 2-9), comprising the steps of:

Downloading an affiliate order window to the client system from the affiliate server system (column 3, lines 20-56);

Uploading transaction details from the client system to the affiliate server system (column 3, lines 20-27; column 11, lines 21-23 and lines 41-43);

Displaying a post-sale opportunity on the client system, wherein the post-sale opportunity includes upsell details that comprise the transaction details (column 8, lines 7-9; column 11, lines 5-18);

If the post-sale opportunity is accepted at the client system, performing the steps of:

Transferring the upsell details to the upsell server system (column 12, lines 2-6);

Downloading an upsell offer from the upsell server to the client system (column 12, lines 2-14);

If the upsell offer is accepted, processing an upsell offer at the upsell server system using the upsell details (column 12, lines 2-14).

Regarding claim 2, Walker 02 discloses the method comprising the step of

running an upsell script from the affiliate order window to cause the post-sale

opportunity to be displayed to the client system (column 7, lines 49-59).

Regarding claim 3, Walker 02 discloses the method wherein the transaction

details include customer information and order information (column 6, lines 41-53;

column 7, line 55 – column 8, line 3; column 10, lines 26-37);

Regarding claim 4, Walker 02 discloses the method wherein the upsell offer is

determined by examining a promotional identifier to the affiliate server system from the

upsell server system (column 7, lines 55-67).

Regarding claim 5, Walker discloses the method wherein the upsell offer is

determined by analyzing the upsell details; selecting an upsell offer based on the

analyzed upsell details (column 7, line 55 – column 8, line 3; column 8, lines 50-58).

Regarding claim 6, Walker 02 discloses the method wherein the customer

information includes payment details (column 6, lines 41-53; column 10, lines 45-51;

column 11, lines 21-23 and lines 41-51).

Regarding claim 7, Walker 02 discloses the method wherein the step of

processing the upsell order at the upsell server system includes the steps of analyzing

the payment details in the transaction details; and securing payment for the upsell order

using the payment details (column 12, lines 7-20).

Regarding claim 8, Walker 02 discloses the method wherein the post-sale

opportunity and the upsell offer are displayed on the client system in the form of a pop-

up window (column 11, lines 63-67).

Regarding claim 9, Walker 02 discloses a system for transacting commerce on

the world wide web (column 3, lines 20-56), comprising:

An affiliate website having a system for processing a transaction with a client and

for receiving transaction details from the client (column 3, lines 3-56; column 7, lines 8-

12; column 11, lines 21-24; column 12, lines 2-9); and

An upsell server, wherein the upsell server includes:

A system for capturing the transaction details from the client during the

transaction between the affiliate website and the client (column 11, line 1- column 12,

line 6);

A system for providing an upsell offer to the client during the transaction between

the affiliate website and the client (column 3, lines 18-20; column 8, lines 7-9; column

11, lines 5-18); and

A system for completing an upsell order with the client using the captured

transaction details (column 12, lines 2-20).

Regarding claim 10, Walker 02 discloses the system further comprising an upsell

script that is run during the transaction between the affiliate website and the client to

create a pop-up window (column 7, lines 49-59; column 11, lines 63-67).

Regarding claim 11, Walker 02 discloses the system wherein the pop-up window

causes the client to transfer transaction details to the upsell server (column 11, line 63 –

column 12, line 6).

Regarding claim 12, Walker 02 discloses the system wherein the pop-up window

causes affiliate details that include a promotional identifier to be transferred to the upsell

server (column 7, lines 55-67).

Regarding claim 13, Walker 02 discloses the system wherein the transaction

details include customer details (column 6, lines 41-53; column 7, line 55 – column 8,

line 3; column 10, lines 26-37).

Regarding claim 14, Walker 02 discloses the system wherein the customer

details include payment information (column 6, lines 41-53; column 10, lines 45-51;

column 11, lines 21-23 and lines 41-51).

Regarding claim 15, Walker 02 discloses the system wherein the transaction

details include affiliate order information (column 11, lines 1-33; column 12, lines 17-36).

Regarding claim 16, Walker 02 discloses the system wherein the upsell website further includes a system for selecting the upsell offer from a plurality of upsell offers (column 8, lines 18-62; column 14, line 63 - column 15, line 9).

Regarding claim 17, Walker 02 discloses the system wherein the system for selecting the upsell offer selects the upsell offer based on transaction details (column 7, line 55 – column 8, line 6).

Regarding claim 18, Walker 02 discloses the system wherein the upsell website further includes a system for selecting the upsell offer from a plurality of upsell offers based on the affiliate identifier (column 7, line 55 – column 8, line 6).

Regarding claim 19, Walker 02 discloses the system wherein the upsell website further includes a system for processing the upsell order (column 11, line 63 – column 12, line 16).

Regarding claim 20, Walker 02 discloses a program product stored on a recordable media, that when executed, includes:

Means for capturing transaction details during the processing of a transaction between an affiliate server and a client (column 11, line 1- column 12, line 6);

Means for providing an upsell offer to the client during the transaction between the affiliate server and the client (column 3, lines 18-20; column 8, lines 7-9; column 11, lines 5-18); and

Means for completing an upsell order with the client using the captured transaction details (column 12, lines 2-20).

Regarding claim 21, Walker 02 discloses the program product wherein the program product is executable on a system that includes the affiliate server (column 3, lines 24-56).

Regarding claim 22, Walker 02 discloses a hub system for brokering upsell opportunities between affiliate servers and upseller servers (column 3, lines 18-56), comprising:

Means for capturing upsell opportunities during the execution of transaction between the affiliate servers and their respective clients, wherein each upsell opportunity includes transaction details (column 7, lines 57-67; column 11, lines 1-62); and

Means for transmitting the captured upsell opportunities to at least one selected upsell server during the execution of said transaction (column 10, lines 52-65; column 11, line 63 – column 12, line 6).

Regarding claim 23, Walker 02 discloses a system for transacting commerce on the world wide web (column 3, lines 18-56), comprising:

An affiliate website having a system for processing a transaction with a client and for receiving transaction details from the client (column 3, lines 3-56; column 7, lines 8-12; column 11, lines 21-24; column 12, lines 2-9); and

An upsell server, wherein the upsell server includes:

A system for capturing the transaction details during the transaction between the affiliate website and the client (column 11, line 1- column 12, line 6); and

A system for providing upsell content to the client during the transaction between the affiliate website and the client (column 3, lines 18-20; column 8, lines 7-9; column 11, lines 5-18).

Regarding claim 24, Walker 02 discloses the system wherein the upsell content is determined based on the captured transaction details (column 7, line 55 – column 8, line 6).

Regarding claim 25, Walker 02 discloses a method of transacting commerce on a network having a client system (column 3, lines 20-27), an upsell server system (column 3, lines 3-6; column 7, lines 33-37; column 12, lines 2-9), and an affiliate server system (column 3, lines 3-6; column 7, lines 8-12; column 12, lines 2-9), comprising the steps of:

Downloading an affiliate order window to the client system from the affiliate

server system (column 3, lines 20-56);

Uploading transaction details from the client system to the affiliate server system

(column 3, lines 20-27; column 11, lines 21-23 and lines 41-43);

Displaying a post-sale opportunity on the client system (column 8, lines 7-9;

column 11, lines 5-18);

If the post-sale opportunity is accepted at the client system, performing the steps

of:

Downloading an upsell offer from the upsell server to the client system (column

12, lines 2-14); and

If the upsell offer is accepted, processing an upsell offer at the upsell server

system using the upsell details (column 12, lines 2-14).

Regarding claim 27, Walker 02 discloses the method wherein the transaction

details include name (column 10, lines 26-37), payment (column 12, lines 7-20), and

affiliate information (column 7, line 55 – column 8, line 3).

Regarding claim 28, Walker 02 discloses the method wherein the transaction

details include a unique identifier (column 10, lines 45-51).

Regarding claim 29, Walker 02 discloses the method wherein the unique

identifier is generated by the affiliate server (column 3, lines 2-6; column 10, lines 42-

51).

Regarding claim 30, Walker 02 discloses wherein the unique identifier is

captured from the order window (column 11, lines 5-23).

Regarding claim 31, Walker 02 discloses the method wherein the post-sale

opportunity is displayed in a pop-up window (column 11, lines 63-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker 02 as applied to claim 25 above, and further in view of U.S. Patent No. 6,055,513 to Katz et al. (further referred to as Katz). Walker 02 does not disclose the method wherein the post-sale opportunity is generated by the upsell server. However, Katz discloses the method wherein the post-sale opportunity is generated by the upsell server (column 8, lines 46-62; column 14, lines 12-29; column 15, lines 60-65; column 16, lines 23-31; column 17, lines 15-34; column 19, lines 23-57; column 20, lines 5-10 and 39-41). It would be obvious to one of ordinary skill in the art to combine the practice of the upseller generating the post-sale opportunity as disclosed by Katz with the Upsell offering system as disclosed by Walker 02. The motivation would be that the Internet allows for any number of individuals and/or entities to access the web and to provide advertisements, banners, sale offers, etc. through the use of pop-up windows, and links to a second web site when the potential customer visits a first web site.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker 02 as applied to claim 25 above, and further in view of "marchFIRST HostOne Established iFrame Partner Program" in PR Newswire, July 19, 2000 (further referred to as march). Walker 02 discloses the method wherein the post-sale opportunity is displayed in a frame or a window (column 11, lines 63-67). Walker does not disclose where the frame and/or window is an iFRAME window. However, march discloses the use of iFrame (page 1, lines 17-18 and page 2, lines 5-6, lines 10-11 and lines 36-39).

It would be obvious to one of ordinary skill in the art to combine the use of iFRAMEs as disclosed by march with the upsell system as disclosed by Walker 02. The motivation would be to use various forms of windows and frames in order to interface with servers in offering upsell offers.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3628

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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600